

Mailed:
September 27, 2005

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re La Estancia Argentina, Corp.

Serial No. 76507514

David A. Gast of Malloy & Malloy for La Estancia Argentina, Corp.

Zachary B. Bello, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Chapman, Zervas and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On April 17, 2003, La Estancia Argentina, Corp.
(applicant) applied to register the mark
LAESTANCIAARGENTINA, in the special form show below, on the
Principal Register for "retail grocery store; on-line
retail store services featuring groceries."



Applicant claimed both first use and first use in commerce on October 22, 2002. Applicant also provided the following translation: "The English translation of the mark 'LA ESTANCIA ARGENTINA' is 'The Argentine Ranch.'"

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of Registration No. 2846740 which issued May 25, 2004 for the mark DE LA ESTANCIA, in standard character form, for "packaged cornmeal and packaged polenta." The cited registration includes the following translation: "The foreign wording in the mark translates into English as 'of the estate.'" Applicant has appealed from the refusal. For the reasons stated below, we reverse.

Procedural Issues

At the outset we must address a number of procedural irregularities. First, this appeal was premature as filed. The examining attorney issued the first office action on November 3, 2003 requiring a translation and noting an earlier-filed, potentially conflicting application,

specifically the DE LA ESTANCIA application which matured into the cited registration. In noting the pending application, the examining attorney used the standard language indicating that if the referenced application matured into a registration "the examining attorney may refuse registration" (emphasis added); the action did not include a refusal. Applicant responded by providing the translation and arguing against any potential conflict with the noted application.

In the following office action, mailed on June 18, 2004, the examining attorney issued a first refusal under Section 2(d) based on the DE LA ESTANCIA registration which had issued in the interim, and he required a new drawing. The office action included the standard six-month response clause and advised applicant that it could submit evidence and arguments in support of registration. The office action did not indicate that the refusal was final. In fact, a final action would have been improper because the action stated the refusal and the requirement for a new drawing, both for the first time. See Trademark Rules 2.61 through 2.64, 37 C.F.R. §§ 2.61 through 2.64. However, the PTO's automated status records identify this office action as a "final refusal." Applicant responded to the action with a "request for reconsideration"; such a request would

be appropriate only after a final refusal. Trademark Rule 2.65(b), 37 C.F.R. § 2.65(b).

The examining attorney should have treated the "request for reconsideration" simply as a response to a first refusal. Instead, in an office action dated January 19, 2005, the examining attorney summarily denied the request and advised that applicant's time for appeal ran "from the date the final action was mailed" even though there had been no final action. In fact, applicant had already filed its notice of appeal on January 3, 2005, within six months of the previous action and also well before the examining attorney denied applicant's "request for reconsideration."

Although the appeal was premature, we conclude that no useful purpose would be served by requiring applicant to refile the appeal. We will construe the examining attorney's denial of applicant's "request for reconsideration" as a repetition of the Section 2(d) refusal, and we will proceed to decide the appeal. See Trademark Rule 2.141, 37 C.F.R. § 2.141.

We must also address irregularities in the submission of evidence. The Board's rules explicitly preclude the submission of new evidence with appeal briefs, subject to limited exceptions not relevant here. Trademark Rule

2.142(d), 37 C.F.R. § 2.142(d). The only evidence the examining attorney submitted in this case was filed with his appeal brief. Applicant has objected to this evidence as untimely. Although the process in this case was truncated due to the premature filing and acceptance of the appeal, the examining attorney had several opportunities to submit evidence, most notably with his denial of applicant's request for reconsideration which the examining attorney issued after applicant had filed its notice of appeal. The examining attorney did not do so. The evidence the examining attorney filed with his brief was untimely and will not be considered.

The applicant also submitted additional evidence with its main brief and still more with its reply brief in violation of the Board's rules.¹ Applicant submitted a listing of third-party registrations and additional Internet evidence with its main brief and copies of the full electronic records related to those registrations from the PTO's on-line data base with its reply brief. This evidence was untimely and will not be considered.²

¹ See authorities cited in TBMP § 1207.01 (2d ed. rev. 2004).

² See authorities cited in TBMP § 1207.03 (2d ed. rev. 2004). Also with the appeal briefs, both the examining attorney and applicant submitted dictionary definitions as to which we may, at our discretion, take judicial notice. We will do so, as appropriate. See authorities cited in TBMP § 1208.04 (2d ed. rev. 2004).

The Likelihood of Confusion Refusal

Turning to the merits of the case, Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent & Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." 15 U.S.C. § 1052(d).

The opinion in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. In doing so the Court recognized that we must decide each case according to its unique facts and that one factor may play a dominant role in a particular case. Id. at 567. We discuss below the factors relevant here, principally the marks and the goods and services of the applicant and registrant.

The Marks

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Appearance - The marks of both applicant and registrant include the term ESTANCIA. However, there are also differences between DE LA ESTANCIA, on the one hand, and LaEstanciaArgentina in a design (shown above), on the other hand. While the examining attorney asserts that ESTANCIA is the dominant element, we do not agree for reasons we explore in our discussion of the connotation of the marks below. Furthermore, as noted, the word elements in the marks differ, and the presentation of applicant's mark, without spacing and with underlining and a surrounding box with distinct upper and lower areas, differentiates the marks further. Although the differences are not overwhelming, we conclude that the marks are not similar when viewed overall.

Sound - There are also differences in sound. The addition of the term ARGENTINA to applicant's mark is particularly significant in this regard. Here again, although the differences are not stark, we conclude that the marks are not similar in sound when considered overall.

Connotation - In this case the connotation of the marks, as well as the commercial impression, are of particular significance. Applicant argues that the

significance of ESTANCIA is altered significantly when it is combined with ARGENTINA. Applicant states:

Applicant by adding the dominant word "ARGENTINA" to the mark has made a considerable effort to evoke the image of wholesome quality and style of flavoring of products from the cattle ranches in South America. When reflecting on the mark, one envisions a rustic ranch setting with gauchos herding cattle, with the sun setting over the Andes Mountains."

Applicant's Brief at 7.

Applicant has provided evidence to support the association between Argentina and beef. In its response to the first office action applicant provides excerpts from www.argentina-spanish.com which states, "Argentina is well known throughout the world for the excellence of its meat which is the result of the first rate cattle industry developed in the country."

Both applicant and the examining attorney proffered various dictionary definitions for "estancia" with the appeal briefs, and they have argued extensively with regard to the proper translation of "estancia" in both the application and registration.

We have consulted some Spanish/English dictionaries and find the following entries most relevant and representative³:

Collins Spanish Dictionary (6th ed. 2000) - **estancia** - (3) (LAm) [de ganado] farm; cattle ranch; (= hacienda) country estate; (Caribe) (= quinta pequena) small farm, smallholding.

Cassell's Spanish-English English-Spanish Dictionary (1978) - **estancia**, n.f. stay; room; habitation; day in the hospital or fee for it; stanza; (*Hisp. Am.*) ranch; farm.

The American Heritage Spanish Dictionary (2nd ed. 2001) - **estancia** f. (*mansion*) country house, estate, (*sala*) room; (*estadia*) stay <una e. en el hospital a hospital stay>; POET. stanza; AMER. (*hacienda*) ranch, farm; (*ganaderia*) cattle ranch.

The evidence supports applicant's argument that the meaning of "estancia" may vary. Cf. In re Buckner Enterprises, Corp., 6 USPQ2d 1316, 1316 (TTAB 1987).

Applicant's further argument--that the meaning within the context of its mark, which includes "Argentina," would indicate "ranch"--is also reasonable in view of the evidence of the association of Argentina with beef and cattle ranches.

As we indicated previously, the registrant translated its own mark as "of the estate." In the absence of

³ We take judicial notice of these dictionary definitions under the authorities cited in TBMP § 1208.04 n. 187 (2d ed. rev. 2004).

evidence that a registrant's translation is misleading or otherwise incorrect we defer to the registrant's own translation of a mark and the associated connotation. On this record, the connotation of "DE LA ESTANCIA" translated as "of the estate" as used on packaged cornmeal or polenta is distinctly different from the connotation of "LA ESTANCIA ARGENTINA" translated as "Argentine Ranch" as used in connection with retail grocery store services or on-line grocery services. Accordingly, we conclude that, on this record, the marks, when viewed overall and in light of their translations, have distinctly different connotations. Cf. Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998).

Commercial Impression - We likewise conclude that the commercial impressions engendered by the marks differ due to the differences in connotation and the further differences resulting from the particular display of applicant's mark.

The Goods and Services

Registrant's goods are "packaged cornmeal and packaged polenta." Applicant's services are "retail grocery store; on-line retail store services featuring groceries." Although food and beverages and services related to food and beverages are sometimes considered "related," here we

must decline to hold them related in the absence of evidence. Specifically, there is no evidence of record to support the conclusion that the same mark, or even similar marks, have been used in conjunction with both the goods of registrant and the services of applicant. See In re Coors Brewing Co., 343 F.3d 1348, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003); In re Mars, Inc., 741 F.2d 395, 222 USPQ 938, 938 (Fed. Cir. 1984).⁴

Conclusion

After consideration of all evidence bearing on the du Pont factors in this ex parte record, we conclude that there is not a likelihood of confusion principally due to the cumulative differences between the marks and the goods and services of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("In our opinion, the cumulative differences between the respective goods and the respective

⁴ The examining attorney has made a number of assertions with regard to the products and services at issue, the channels of trade and prospective purchasers. Examining Attorney's Brief at 2. These assertions are based, in part, on evidence we have excluded as untimely. The arguments themselves are also misplaced to the extent they impose restrictions on the trade channels of applicant or registrant not specified in the application or registration. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Ser No. 76507514

marks are sufficient to preclude likelihood of confusion, mistake, or deception."); Steve's Ice Cream v. Steve's Famous Hot Dogs, 3 USPQ2d 1477, 1478 (TTAB 1987).

Decision: The refusal to register under Section 2(d) of the Act is reversed.